

FC3 International Patent Law
FINAL Mark Scheme 2024

SECTION A

Question 1

You are the appointed representative for your client, who is the owner of EP-1, a European patent application that was filed in English. The Examining Division has issued a communication under Rule 71(3) EPC, informing you of the text in which it intends to grant EP-1 as a European patent.

a) Outline the steps that need to be taken before the EPO, in order to bring EP-1 to grant. Include any deadline(s) by which the steps need to be taken. You are not required to take into account possible extensions of the deadline(s).

4 Marks

b) Identify what translations (if any) are required as part of validation of EP-1 in the following EPC member states. Explain why translations are (or are not) needed:

Spain
France
Netherlands

7 marks

c) Outline the steps required to request a unitary patent, including the deadline by which the steps need to be taken.

4 marks

Total: 15 Marks

Answer

a)
(Rule 71(3) EPC). Within four months of the date of the communication under Rule 71(3) EPC **(1 mark)**,
pay the fee for grant and publishing **(1 mark)**, and
file a translation of the claims **(1 mark)** into French and German / the two other official language of the EPO **(1 mark)**.

4 marks

b)
(Article 65 EPC)
Spain: An entire translation of the specification is required **(1 mark)**, because English is not an official language of Spain / does not share an official language of EPO **(1 mark)**.

France: No translations are required **(1 mark)**, because France is party to the London agreement / has dispensed with translation requirements **(1 mark)**.

Netherlands: Only claims must be translated into Dutch **(1 mark)**, because the Netherlands is party to the London agreement **(1 mark)** and permits the description to be in English **(1 mark)**.

7 marks

c)

File a request for unitary effect at the EPO (0.5 marks) no later than one month after publication of the mention of grant of EP-1 (0.5 mark).

Include a translation of the entire specification into another official language of the EU (1 marks).

File the request in writing (0.5 marks).

Provide particulars of the proprietor (0.5 marks).

Provide the patent number of EP-1 (0.5 marks).

Provide the particulars of the appointed representative (0.5 marks).

(UPR 6(1) and 6(2))

4 marks

Total: 15 marks

Question 2

For each of the following countries, state whether a grace period for the applicant's own prior disclosure is available: Australia, Israel, Mexico, Singapore, South Korea, United States.

Total: 3 marks

Answer

Yes (0.5 marks each): Australia, Mexico, Singapore, South Korea, United States.

No (0.5 marks each): Israel (or "Yes", with reasoned discussion regarding narrow exceptions).

Total: 3 marks

Question 3

Outline the procedure for filing an opposition to a granted Japanese patent.

Total: 3 marks

Answer

Any of the following up to 3 marks:

Any person may file an opposition to the grant of the patent (1 mark).

within six months after publication of grant of the patent (1 mark).

An opposition fee must be paid (1 mark).

The opposition must include the particulars of the patent (1 mark),

reasons for the opposition (1 mark),

and indication of supporting evidence (1 mark).

Total: 3 marks

Question 4

Your client contacts you in relation to a previously filed PCT patent application, WO-1.

The PCT patent application was filed on 27 August 2024, and claims a priority date of 27 August 2023. Upon reviewing the filing receipt of the application, you notice a typographical error in the applicant's name.

a) State the competent authority to decide on the request for correction. Give a reason for your answer.

2 marks

b) Outline the criteria that must be met for the request for correction to be accepted, and the documents that would be considered by the competent authority.

5 marks

c) What is the deadline for submitting the request for correction? You are not required to take into account any patent office closed days.

2 marks

Total: 9 Marks

Answer

a)

The Receiving Office (1 mark), because as the error is in the request part of the international application (1 mark). (Rule 91.1 PCT)

2 marks

b)

The request for correction will be accepted if it is obvious (0.5 marks) to the competent authority that, at the filing date (0.5 marks), something else was intended than what appears in the document concerned (1 mark) and that nothing else could have been intended than the proposed rectification (1 mark). The competent authority will take into account the content of the international application itself (0.5 marks), the correction concerned (0.5 marks), any other document submitted with the request (0.5 marks) and any other document contained in the international application file at the applicable date/filing date (0.5 marks). (Rule 91.1 PCT)

5 marks

c)

26 months from the priority date (1 mark), so 27 October 2025 (1 mark). (Rule 91.2 PCT)

2 marks

Total: 9 Marks

Question 5

Your client filed a PCT application having a priority date of 18 September 2022 and now wishes to seek protection in several countries, including the United States. Your client is a UK limited company having seven employees and is pre-revenue generating. It has not filed any previous patent applications in the United States. It has, however, licensed the invention claimed in the PCT application to a not-for-profit research organisation.

a) Identify the deadline for filing a national phase application in the United States. You are not required to take into account any patent office closed days.

1 mark

b) Identify the types of entity status at the USPTO and describe the requirements for each.

6 marks

c) Conclude which entity status applies to your client. Give reasons for your answer.

3 marks

Total: 10 mark

Answer

a)

The deadline for filing the US national phase application is 30 months from the priority date (0.5 marks), i.e., 18 March 2025 (0.5 marks).

1 mark

b)

The USPTO will assign one of micro entity, small entity or large entity to your client (1 mark for listing all three).

Any of the following up to 5 marks:

To be a small entity, the client must be an individual, a small business concern (including affiliates) / a company having not more than 500 employees, or a university or a not for profit organisation (1 mark), and must not have assigned, licensed or otherwise conveyed an interest in the invention to a non-small entity (or be legally obligated to do so) (1 mark).

To be a micro entity, the client must qualify as a USPTO-defined small entity (1 mark), not be named on more than four previously filed US applications (1 mark), not have a gross income more than three times the median household income in the previous year from when the fee(s) is paid (1 mark), and not have or be under an obligation to assign, grant, or convey a license or other ownership to another entity that does not meet the same income requirements as the inventor (1 mark).

If the small entity or micro entity status requirements are not met, large entity status will apply (1 mark).

6 marks

c)

On the facts, the client is a micro entity (1 mark for correct conclusion, 2 marks for application of facts to requirements).

3 marks

Total: 10 marks

TOTAL FOR SECTION A: 40 marks

SECTION B

Question 6

According to *Article 54 EPC* and *Article 56 EPC*, novelty and inventive step of an invention is assessed with regard to the state of the art.

a) Discuss what is comprised by the state of the art, and the relevant date by which the state of the art is assessed.

7 marks

Your client owns the following IP portfolio:

EP-1, a European patent application. EP-1 was filed on 4 April 2018 without a priority claim. It was published on 25 October 2019, and subsequently deemed withdrawn for failure to respond to an examination report.

EP-2, a European patent application. EP-2 was filed on 1 April 2021 and claims a priority date of 5 September 2020. It was published on 10 March 2022.

DE-1, a German national patent application. DE-1 was filed on 27 August 2020 without a priority claim. It was published on 1 March 2022.

Your client is very concerned about their main competitor's key European patent, EP-X, and wonders if their IP portfolio could be used to oppose EP-X. EP-X was filed on 5 September 2021 and claims a priority date of 5 September 2020. Publication of mention of grant of EP-X occurred on 10 July 2024.

b) Prepare notes for a call with your client, explaining whether each of EP-1, EP-2 and DE-1 can be cited against EP-X for novelty and inventive step, in an EPO opposition. Explain your reasoning and state any assumptions that you make.

9 marks

c) Discuss the requirements and time limit for opposing EP-X at the EPO. You are not required to take into account any patent office closed days.

4 Marks

Total: 20 Marks

Answer

a)
Everything (1 mark) made available to the public (1 mark), before the date of filing of a European patent application for the invention (1 mark) (Article 54(2) EPC).

Additionally, the content of European patent applications (1 mark) as filed, the dates of filing of which are prior to the filing date of the relevant European patent application (1 mark), and which were published on or after that date (1 mark) (Article 54(3) EPC).

Assuming priority entitlement is valid (0.5 marks), the date of priority counts as the date of filing of a European patent application (0.5 marks), for the purposes of assessing the state of the art (Article 89 EPC).

7 marks

b)

EP-1 was published before the priority date of EP-X **(1 mark)** and is therefore citable against EP-X under Article 54(2) EPC / is citable for novelty and inventive step **(1 mark)**.

EP-2 has the same priority date as EP-X / was not filed before EP-X **(1 mark)** and therefore cannot be cited against EP-X under Article 54(2) or 54(3) EPC / cannot be cited for novelty or inventive step **(1 mark)**.

DE-1 was published after the priority date of EP-X **(1 mark)** and therefore cannot be cited under Article 54(2) **(1 mark)**. It is not a European patent application **(1 mark)** and therefore cannot be cited against EP-X under Article 54(3) EPC **(1 mark)** / cannot be cited for novelty or inventive step.

Assumes priority entitlement for EP-2 and EP-X is fully valid / EP-2 and EP-X are identical to their respective priority documents **(0.5 marks for each of EP-2 and EP-X)**.

9 marks

c)

Must file a notice of opposition **(0.5 marks)** within 9 months of publication of mention of grant, i.e. by 10 April 2025 **(0.5 marks)**.

Pay the opposition fee **(0.5 marks)**

Opposition must contain

sufficient identification of / particulars of the client **(0.5 marks)**,

sufficient identification of / the number of EP-X **(0.5 marks)**

a statement of the extent to which EP-X is opposed **(0.5 marks)**, the grounds on which the opposition is based **(0.5 marks)**, and an indication of the facts and evidence in support of these grounds **(0.5 marks)**

4 marks

Total: 20 marks

Question 7

You are the patent attorney for a company that has recently acquired the following patents and patent applications:

A UK patent application (GB-1) filed on 20 September 2023.

A PCT application (WO-2) claiming priority from a German patent application (DE-3) filed on 5 June 2022.

A granted US patent (US-4) only. The grant date was 30 March 2021.

Your company wishes to pursue protection in China, Europe, Japan and the United States, via GB-1 and WO-2. Your company asks you assess if there any upcoming deadlines to meet for all three cases, in order to avoid any loss of rights.

Discuss, in relation to GB-1, WO-2 and US-4, what deadlines will fall due in the next six months. Include in your answer any actions that might be taken to mitigate missed deadlines. You are not required to take into account any patent office closed days.

Total: 20 marks

Answer

GB-1

The priority period expires 12 months from the date of filing of GB-1 (0.5 marks) so on 20 September 2024 (0.5 marks). By this date, the applicant should have filed its PCT application (1 mark). As the deadline was missed, the applicant may file a PCT application within two months of the missed deadline, i.e. by 20 November 2024 (1 mark) and request restoration of priority (1 mark).

At the national/regional phase, restoration of priority will be accepted if: the reason for late filing was unintentional, for China (1 mark), Japan (1 mark) and the United States (1 marks), or was in spite of all due care, for Europe (1 marks).

8 marks

WO-2

National phase applications are due to be filed:

30 months from the priority date for China (0.5 marks), Japan (0.5 marks) and US (0.5 marks), i.e. by 5 December 2024 (0.5 marks) and 31 months from the priority date for Europe (0.5 marks), i.e. by 5 January 2025 (0.5 marks).

A two month extension of time (1 mark) is available in China (1 mark) to file a national phase application.

Missing the 31 month deadline to enter Europe will result in a notification of loss of rights (1 mark). Further processing can be requested within 2 months of this notification (1 mark) together with completing the omitted act(s) (0.5 marks) and paying the further processing fee (0.5 marks).

Failure to file a US national phase application within the 30 month deadline can be mitigated by requesting revival of the national phase within two months of the missed deadline (0.5 marks) if it can be shown that the failure to enter the national phase was unintentional (0.5 marks).

*Failure to file a Japan national phase application within the 30 month deadline can be mitigated by requesting reinstatement of the national phase within one year of the missed deadline **(0.5 marks)** if it can be shown that the failure to enter the national phase was unintentional **(0.5 marks)**.*

10 marks

US-4

*The first renewal fee falls due 3.5 years after the grant date of US-4 **(0.5 marks)** so on 30 September 2024 **(0.5 marks)**. The renewal fee can be paid up to six months after the deadline **(0.5 marks)** so by 30 March 2025 **(0.5 marks)**.*

2 marks

Total: 20 marks

Question 8

Your client asks you to review two of their PCT applications, WO-1 and WO-2.

WO-1 was filed on 10 February 2023, without claiming priority. It only has 2 claims, which are both independent.

WO-1 received the Written Opinion of the International Searching Authority ("WOISA") on 15 September 2024. The WOISA objects that claim 1 lacks novelty, and that claim 2 lacks clarity. Your client tells you that the WOISA objection to claim 1 is certainly correct, but asks if you can amend this claim to include a new feature that was not disclosed in the application as filed. They inform you that the objection to claim 2 can be easily overcome by introducing a feature from the description.

WO-2 was filed in Chinese on 4 December 2023, claiming a priority date of 4 December 2022. It has only two claims, which are both independent. WO-2 received the WOISA on 5 November 2023. The WOISA raised no objections to the claims. The ISA was The China National Intellectual Property Administration (CNIPO).

For WO-1, your client is considering a very wide national phase entry program. However, in order to avoid unnecessary costs, they only want to proceed with this if they are able to obtain an entirely positive patentability opinion during the international phase.

For WO-2, your client is no longer interested in claim 1, and believes claim 2 is only commercially important for Europe. They want to pursue protection for claim 2 as quickly as possible.

a) Devise an international/national prosecution strategy for WO-1 and WO-2 over the next twelve months, that achieves the stated aims for the client. You are not required to take into account any patent office closed days.

16 marks

Your client has also developed a new product that they believe is commercially valuable, but is only a minor modification over what is already known. They are only interested in marketing the product in Germany and Australia.

b) Discuss a suitable intellectual property right that could be used to protect the new product, giving a reason for your answer. State whether the intellectual property right is available in each of the countries of interest.

4 marks

Answer

a)
WO-1

*The client should file a demand for Internal Preliminary Examination **(1 mark)** and pay the prescribed fees **(1 mark)**.*

*The demand must be filed the later of three months from date of transmittal of the WOISA / 22 months from the filing date/priority **(1 mark)**, so by 15 December 2024 **(1 mark)**.*

*The client does not employ any patent attorneys, so their opinion on the WOISA objections may not be accurate **(1 mark)**. Therefore, check to see if you agree with the client's assessment of the WOISA objections **(1 mark)**.*

Assuming you agree with the client, it seems that it will not be possible to obtain a positive opinion on claim 1. Since the new feature was not disclosed in the application as filed, it will not be possible to use it to amend claim 1, because it will attract an added subject-matter objection **(1 mark)**. In order to obtain an entirely positive patentability opinion, the claims should be amended when filing the demand **(0.5 marks)**, by deleting claim 1 or finding an appropriate amendment **(0.5 marks)**. Claim 2 should be amended by including the feature from the description **(0.5 marks)**. You should check that this amendment does not add subject-matter **(0.5 marks)**.

9 marks

WO-2

The client should enter the European regional phase early **(0.5 marks)** and requesting early processing **(0.5 marks)**, as soon as possible **(0.5 marks)**. It will be necessary to pay the filing fee **(0.5 marks)**, search fee **(0.5 marks)**, examination and designation fees **(0.5 marks)**, and file a translation into an EPO official language **(0.5 marks)**.

Since the client is no longer interested in claim 1, they should amend the claims at entry **(1 mark)** by deleting claim 1 **(1 mark)**. (On the form 1200), the client should waive the right to the Rule 161/162 communication **(0.5 marks)** and the Rule 70(2) communication **(0.5 marks)**, and request PACE for accelerated examination, once available **(0.5 marks)**.

7 marks

b)

The client should consider filing for a utility model **(1 mark)**, which has lower or no inventive step requirements **(1 marks)**, i.e. can in principle be used to protect minor modifications. Utility model protection is available in Germany **(1 mark)**, but not in Australia **(1 mark)**.

4 marks

Total: 20 marks

Question 9

Your client filed a United Kingdom patent application, for a cooking utensil with a filing date of 5 December 2023. The cooking utensil is manufactured and sold in China. Your client informs you that their biggest competitor is planning to manufacture a similar cooking utensil in China, that would be covered by the claims of the UK patent application. Your client predicts that the cooking utensil is likely to a market leader for at least 12 years.

a) Devise an appropriate strategy for obtaining patent and utility model protection in China, including outlining the registration procedure in China for utility models and the term of protection. Explain one advantage of a utility model over a patent. You are not required to take into account any patent office closed days.

10 marks

At a subsequent the meeting, your client informs you that they wish to pursue protection for a second cooking utensil in Canada, Mexico, Israel and Saudi Arabia.

b) Outline a cost-effective strategy for obtaining protection in these countries, including any associated deadlines, whether or not claims fees are due and whether utility model protection is available or not.

10 marks

Total: 20 marks

Answer

a)

In China it is possible to obtain protection via both a patent and utility model (1 mark) if both applications are filed at the same time and within 12 months of the priority date of the UK patent application, i.e. by 5 December 2024 (1 mark). Utility models are subject to preliminary examination only (1 mark). This includes examination of the application documents (0.5 marks), ensuring the relevant fees are paid (0.5 marks) and a cursory examination of obvious substantive defects (0.5 marks). If no objections are raised during preliminary examination, the utility model will be registered (0.5 marks). Any person (1 mark) can request substantive examination following registration (1 mark). The utility model will be revoked if objections are raised and not overcome as part of substantive examination (1 mark). Term is 10 years (1 mark).

1 mark for providing any reasonable advantage of seeking utility model protection – no substantive examination, quicker registration, lower inventiveness requirements, etc.

10 marks

b)

File a PCT application (1 mark) within 12 months of the priority date of the UK patent application, i.e. by 5 December 2024 (1 mark).

PCT deadlines: Canada – 30 months (0.5 marks), Mexico – 30 months (0.5 marks), Israel 30 months (0.5 marks), Saudi Arabia – 30 months (0.5 marks).

Canada (0.5 marks) and Israel (0.5 marks) require payment of excess claims fees. Mexico (0.5 marks), Saudi Arabia (0.5 marks) do not.

Reduce number of claims to avoid any claims fees in Canada and Israel (if necessary) (1 mark).

Utility model protection is available in Mexico (0.5 marks) but not in Canada (0.5 marks), Israel (0.5 marks) or Saudi Arabia (0.5 marks). Can file as either a utility model or patent at national phase entry in Mexico (1 mark).

10 marks

Total: 20 marks